

PATENT
(Docket No. IN-5547)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Wolfgang BREMSER

Serial No.: 10/018,352

Filed: January 11, 2002

For: Varnish and Its Use for Producing
Varnish Coatings and Color- and/or
Effect-Producing Multi-Layer
Coatings

Commissioner for Patents

PO Box 1450

Alexandria, VA 22313-1450

Group Art Unit: 1713

Examiner: Robert D. Harlan

I hereby certify that the attached correspondence is being transmitted
via facsimile addressed to Commissioner for Patents, P.O. BOX 1450,
Alexandria, VA 22313-1450, on the date shown below to facsimile
number 1-703-872-9306.

Jan. 1, 2004

Date

MLM

Michael Morgan

RESPONSE TO OFFICE ACTION

In response to the Office Action mailed on March 18, 2004, Applicant responds through his attorney as follows.

REMARKS

The claims pending in the subject application are 1-7 and 13-15. Reconsideration of this application based on the Remarks presented herein is respectfully requested.

On October 21, 2003, an Information Disclosure Statement was mailed. In this IDS, it was indicated that the current application was copending with an application that issued as United States Patent No. 6,506,836 to Bremser et al. and Serial No. 09/868,769 to Bremser et al. United States Patent No. 6,506,836 corresponds to WO00/37507 (published June 29, 2000, filed December 18, 1999), which claims priority to DE 198 58 708 (filed December 18, 1998) and DE 199 09 803 (filed March 5, 1999). Serial No. 09/868,769 corresponds to WO00/39169

(published July 6, 2000, filed December 22, 1999), which claims priority to DE 198 60 011 (filed December 23, 1998) and DE 199 09 752 (filed March 5, 1999). Both of the priority applications for Serial No. 09/868,769 were cited in the International Search Report for the present application and were considered in an IDS. Also, Serial No. 09/868,769 has now issued as United States Patent No. 6,716,905 to Bremser et al., and a copy is enclosed. Neither of these references are prior art under §102 or §103 because the present application is a §371 of a PCT application filed on June 30, 2000, which claims priority to DE 199 30 664, filed July 2, 1999, and this priority date is before the publication date, the international filing date, and the U.S. filing date of these references. While neither of these references are prior under §102 or §103, it is respectfully requested that the present application be reviewed against United States Patent Nos. 6,506,836 and 6,716,905 in view of the judicially created doctrine of obviousness-type double patenting and §101 double patenting.

35 U.S.C. §102 REJECTIONS

Claims 1-7 and 13-15 were rejected under 35 U.S.C. §102(e) as being anticipated by United States Patent No. 6,670,043 to Barkac et al.

In Barkac '043, the material of general formula XI at column 13, line 35 is not reacted with the disclosed polymer in a free radical addition polymerization. Instead, a hydrogen atom on the material is reacted with a halogen atom on the polymer (see column 13, line 64 to column 14, line 20). The ethylenically unsaturated double bond in the material remains in the structure and is not reacted. While the polymer in Barkac '043 can be crosslinked, the crosslink reaction disclosed is between a carboxylic acid group on the polymer and a hydroxyl group on a crosslinking agent (column 19, lines 1-12). There is no disclosure in Barkac '043 of reacting the ethylenically unsaturated double bond by free-radical polymerization.

In independent claims 1 and 2, the olefinically unsaturated monomer represented by general formula I is reacted by free radical polymerization with another olefinically unsaturated monomer. This reaction causes the double bond in one monomer to react with a double bond in another monomer. This reaction results in a different structure than the reaction disclosed in

Barkac '043. Because there is no disclosure in Barkac '043 of reacting the ethylenically unsaturated double bond by free-radical polymerization, it is respectfully submitted that claims 1-7 and 13-15 are not anticipated by United States Patent No. 6,670,043 to Barkac et al.

In view of the remarks contained above, Applicant respectfully requests reconsideration of the application, withdrawal of the 35 USC §102 rejections, and requests that a Formal Notice of Allowance be issued for claims 1-7 and 13-15. Should the Examiner have any questions about the above remarks, the undersigned attorney would welcome a telephone call.

Respectfully submitted,

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